

Practitioner's Docket No. SP-1307 PCT US

PATENT

#5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Konwinski et al.**Application No.: **10 / 521,145**

Group No.:

Filed: **7/22/2003**

Examiner:

For: **Food Coating Composition and Method of Making Same**

RECEIVED

30 DEC 2005

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Legal Staff
International Division

PETITION BY JOINT INVENTOR(S) FILING ON BEHALF OF OTHER JOINT INVENTOR(S) WHO REFUSE(S) TO JOIN IN APPLICATION OR CANNOT BE REACHED (37 C.F.R. § 1.47(a))

NOTE: 37 C.F.R. § 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the non-signing inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

(c) The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the Official Gazette. The Office may dispense with this notice provision in a continuation or divisional application, if notice regarding the filing of the prior application was given to the non-signing inventor(s).

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*

(When using Express Mail, the Express Mail label number is mandatory;
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

☒ deposited with the United States Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

37 C.F.R. § 1.8(a)

37 C.F.R. § 1.10 *

☐ with sufficient postage as first class mail.

☒ as "Express Mail Post Office to Addressee"

Mailing Label No. **EV042959371US** (mandatory)

TRANSMISSION

☐ facsimile transmitted to the Patent and Trademark Office, (703) _____

Date: 8/15/05

Signature

Sheri West

(type or print name of person certifying)

* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

(Petition by Joint Inventor(s) Filing on Behalf of Other Joint Inventor(s) Who Refuse(s) to Join in Application or Cannot Be Reached (37 C.F.R. § 1.47(a)) [1-4.1]—page 1 of 2)

1. I, a joint inventor of the above identified application, sign below and petition to make this application on behalf of the non-signing joint inventor(s):

Thomas R. Katen

Type name of omitted joint inventor

who:

- ☒ refuses to join in the application
☐ cannot be found after diligent effort

2. This petition is accompanied by proof of the pertinent facts and the last known address of the non-signing inventor as set forth in the accompanying:

STATEMENT OF FACTS IN SUPPORT OF FILING ON BEHALF OF NONSIGNING INVENTOR (37 C.F.R. § 1.47).

3. The fee set forth in § 1.17(h) (\$130.00), required by 37 C.F.R. § 1.47(a), is paid as follows:

- ☐ Attached is a ☐ check ☐ money order in the amount of \$ _____
☒ Authorization is hereby made to charge the amount of \$ 130.00
☒ to Deposit Account No. 50-0421
☐ to Credit card as shown on the attached credit card information authorization form PTO-2038.

WARNING: Credit card information should not be included on this form as it may become public.

- ☒ Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.
☐ A duplicate of this paper is attached.

Arthur H. Konwinski

type name of joint inventor who signs

Arthur H. Konwinski
Signature

(Petition by Joint Inventor(s) Filing on Behalf of Other Joint Inventor(s) Who Refuse(s) to Join in Application or Cannot Be Reached (37 C.F.R. § 1.47(a)) [1-4.1]—page 2 of 2)

04/11/2006 CSM00T 00000001 500421 10521145
Sale Ref: 00000001 DA#: 500421 10521145
01 FC:1463 200.00 DA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Konwinski et al.**

For: **Food Coating Composition and Method of Making Same**

the specification of which:

(check and complete (a), (b), or (c))

- (a) ☐ is attached hereto.
- (b) ☒ was filed on 7/22/2003, as Application Serial No. 10 / 521,145
and was amended on _____ (if applicable).
- (c) ☒ was described and claimed in International Application No. PCT/US03/22844
filed on 7/22/2003 and as amended on _____ (if any).

**STATEMENT OF FACTS IN SUPPORT OF FILING
ON BEHALF OF NONSIGNING INVENTOR (37 C.F.R. § 1.47)**

NOTE: This statement as to the pertinent facts concerning the refusal of the nonsigning inventor to join in the application or where the omitted inventor cannot be found or reached must accompany the declaration signed on behalf of the omitted inventor by a joint inventor or by a legal representative who shows a proprietary interest. Where the entity with a proprietary interest executes the declaration on behalf of the omitted inventor there must also be a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. 37 C.F.R. §§ 1.47(a) and (b).

This statement is made as to the exact facts that are relied upon to establish the diligent effort made to secure the execution of the declaration by the nonsigning inventor for the above-identified patent application before deposit thereof in the Patent and Trademark Office.

(check next item, if applicable)

- ☐ Because signing on behalf of the nonsigning inventor is by a person or entity showing a sufficient proprietary interest, this statement also recites facts as to why this action was necessary to preserve the rights of the parties or to prevent irreparable damage.

This statement is being made by the available person having first-hand knowledge of the facts recited therein.

NOTE: The statement "must be signed, where at all possible, by a person having first-hand knowledge of the facts recited therein." M.P.E.P. § 409.03(d), 7th ed. If different persons have first-hand knowledge of different facts, then a declaration from each such person as to those facts he or she knows should be submitted separately.

NOTE: Copies of documentary evidence, such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions. M.P.E.P. § 409.03(d), 7th ed.

IDENTIFICATION OF PERSON MAKING THIS STATEMENT OF FACTS

Arthur H. Konwinski

Name

5931 Hinsdale Lane

Address

Fort Wayne, Indiana 46835 US

EFFORTS DURING CONVENTION YEAR TO PREPARE APPLICATION AND OBTAIN INVENTOR'S SIGNATURE

NOTE: *In cases where priority under 35 U.S.C. § 119 is to be claimed, the 37 C.F.R. § 1.47 applicant should explain what efforts, if any, were made during the Convention year to prepare the application and obtain the inventor's signature thereon. The period allowed by the Convention year should "be sufficient for the preparation and deposit of an application . . . in the form required by the rules." . . . Accordingly, 37 C.F.R. § 1.47 may not be used "to save the parties from the consequences of their delay." M.P.E.P. § 409.03(d), 7th ed.*

(use Supplemental Page(s), if necessary)

LAST KNOWN ADDRESS OF THE NONSIGNING INVENTOR

NOTE: MPEP, § 409.03(e), 8th Edition:

"An application filed pursuant to 37 CFR 1.47 must state the last known address of the nonsigning inventor.

"That address should be the last known address at which the inventor customarily receives mail. See MPEP § 605.03. Ordinarily, the last known address will be the last known residence of the nonsigning inventor.

"Inasmuch as a nonsigning inventor is notified that an application pursuant to 37 CFR 1.47 has been filed on his or her behalf, other addresses at which the nonsigning inventor may be reached should also be given."

Full name of nonsigning inventor

Thomas R. Katen

Last known address of nonsigning inventor

3875 Wildshire East Road, Willshire, Ohio 45898

NOTE: Ordinarily, the last known address will be the last known residence of the nonsigning inventor, but other addresses at which the nonsigning inventor may be reached should also be given in the space below. M.P.E.P. § 409.03(e), 6th ed.

DETAILS OF EFFORTS TO REACH NONSIGNING INVENTOR

NOTE: Complete either these facts or the facts as to REFUSAL OF NONSIGNING INVENTOR TO SIGN APPLICATION PAPERS or both, in applicable circumstances.

NOTE: "The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions." MPEP, § 409.03(d), 8th Edition.

On June 23, 2005, James L. Cordek received a Notification of Missing Requirements under 35 USC 371 in the United States Designated/Elected Office (DO/EO/US). This notification stated that the oath or declaration does not comply with 37 CFR 1.497 (a) and (b), in that it is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.

On July 19, 2005, James L. Cordek sent a copy of the filed patent application and a copy of the combined declaration and power of attorney identifying the application by the international application number and international filing date to Thomas R. Katen, by Express Mail. A copy of the letter and a copy of the Express Mail customer copy receipt is attached.

On August 1, 2005, James L. Cordek phoned Mr. Katen (419.495.2220) to discuss the declaration. He stated that he would sign the declaration and would return it to James L. Cordek.

On August 5, 2005, James L. Cordek sent another copy of the filed patent application along with another copy of the combined declaration and power of attorney identifying the application by the international application number and international filing date to Thomas R. Katen, again by Express Mail. A copy of that letter and a copy of the Express Mail customer copy receipt is attached.

As of August 15 2005, the signature date of this paper, no signed declaration has been received from Mr. Katen.

(use Supplemental Page(s), if necessary)

DETAILS OF REFUSAL OF NONSIGNING INVENTOR TO SIGN APPLICATION PAPERS

NOTE: Complete either these facts or the facts as to **DETAILS OF EFFORTS TO REACH NONSIGNING INVENTOR** or both, in applicable circumstances.

NOTE: MPEP, § 409.03(d), 8th Edition:

"A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

"Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

"Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

"When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition."

(use Supplemental Page(s), if necessary)

PROOF OF NEED TO PREVENT IRREPARABLE DAMAGE OR PRESERVE THE RIGHTS OF THE PARTIES

NOTE: *This proof must be presented where the declaration is signed by a person with sufficient proprietary interest for the nonsigning inventor (37 C.F.R. § 1.47(b)), but is not a requirement when the person signing for the nonsigning inventor is a joint inventor. (37 C.F.R. § 1.47(a)).*

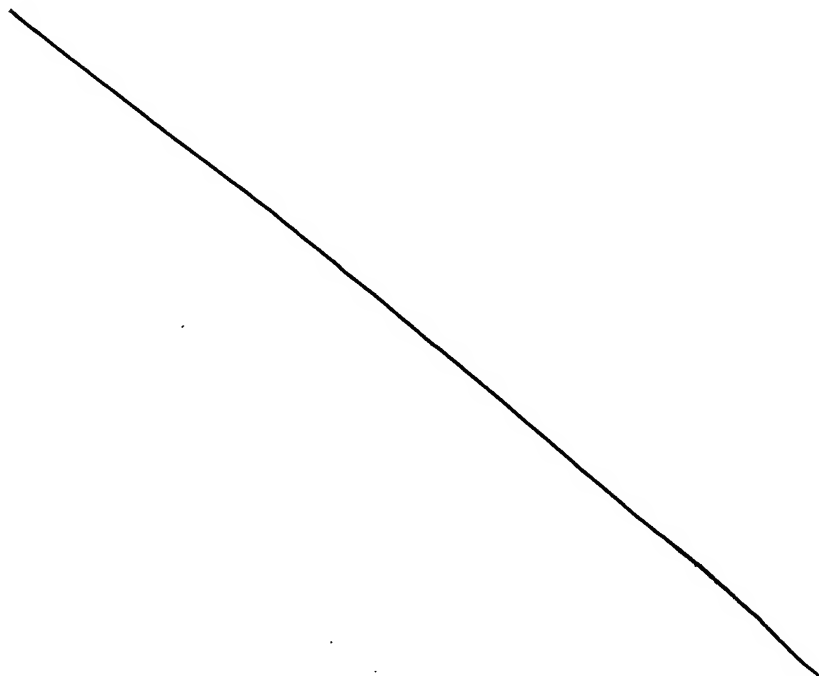
If a statutory bar is involved, the act or publication which is believed to constitute the bar should be identified. If a claim for priority is involved, the prior application or applications should be identified.

A diligent effort to prepare the application and obtain the inventor's signature thereon must be made, even if the application is being filed to avoid a bar or to claim priority. M.P.E.P. § 409.03(g), 7th ed.

Irreparable damage may be established by showing that a filing date is necessary to (1) avoid a statutory bar or (2) make a claim for priority, which should identify the prior application(s) involved.

Preservation of the rights of the parties may be demonstrated by a showing that the nonsigning inventor may reasonably be expected to enter into competition with the person having a proprietary interest and signing on behalf of the nonsigning inventor or that a firm plan for commercialization of the subject matter of the application has been adopted.

M.P.E.P. § 409.03(g), 7th ed.



*(if this proof is not needed and not being presented,
then draw a line through this page of the form.)*

(use Supplemental Page(s), if necessary)

Date: 8/15/05



Signature of person making statement

Arthur H. Konwinski

☐ Plus _____ Added Page(s)

Rec'd PCT/PTO 15 AUG 2005

~~del 6-26-05~~ del 11:37 7-2005 R. Katen
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PO ZIP Code 63115	Day of Delivery <input checked="" type="checkbox"/> Next <input type="checkbox"/> Second	Flat Rate Envelope <input type="checkbox"/>
Date In 7 19 05 Mo. Day Year	<input type="checkbox"/> 12 Noon <input checked="" type="checkbox"/> 3 PM	Postage \$ 13.65
Time In 17 12 <input type="checkbox"/> AM <input checked="" type="checkbox"/> PM	Military <input type="checkbox"/> 2nd Day <input type="checkbox"/> 3rd Day	Return Receipt Fee
Weight 2 lbs. 0 oz.	Int'l Alpha Country Code	COD Fee Insurance Fee
No Delivery <input type="checkbox"/> Weekend <input type="checkbox"/> Holiday	Acceptance Clerk Initials [Signature]	Total Postage & Fees \$ 13.65

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 Express Mail Corporate Acct. No. _____

FEDERAL AGENCY ACCT. NO. OR POSTAL SERVICE ACCT. NO. _____

FROM: (PLEASE PRINT) PHONE () _____

James L. Cordek
 Solae LLC
 Building 3C
 PO Box 88940
 St. Louis, MO 63188
 SP-1307; Mailed July 19, 2005

TO: (PLEASE PRINT) PHONE () _____

Thomas R. Katen
 3875 Wildshire
 Willshire, OH 45098

JUL 21 2005

FOR PICKUP OR TRACKING CALL 1-800-222-1811 www.usps.com



Customer Copy
 Label 11-F August 2000

*The Solae[®]
Company*

RECEIVED PCT/PTO 15 AUG 2005

Solae, LLC
P.O. Box 88940
St. Louis, MO 63188 USA
800.325.7108

August 5, 2005

Express Mail Label No. EV 042959969 US

Thomas R. Katen
3875 Wildsire East Road
Willshire, OH 45898

EV042959969US

re: SP-1307 US Declaration for Patent Application titled, **FOOD COATING
COMPOSITION AND METHOD OF MAKING SAME**

International Application Number: PCT/US2003/022844

International Filing Date: July 22, 2003

Tom,

Solae recently filed a patent application directed to the above subject matter in which you are designated an inventor. In order to comply with the US patent law, I am sending to you an assignment and a combined Declaration and Power of Attorney for the above identified subject matter that requires your signature. Please sign and date at the indicated place.

I am also sending you a copy of the patent application identified by the international publication number WO 2004/008873 A1, as filed that you may keep.

As soon as possible, please return the signed assignment and signed combined Declaration and Power of Attorney in the postage paid envelope.

I thank you for your cooperation.

Very truly yours,



James L. Cordek
314.982.2409

Rec^{PT}CT/PTO 15 AUG 2005

del 2:46 pm 8/6 signed by P. Katen
EXPRESS MAIL
POST OFFICE TO ADDRESSEE
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ORIGIN (POSTAL USE ONLY)		
PO ZIP Code 63153	Day of Delivery <input checked="" type="checkbox"/> First <input type="checkbox"/> Second	Flat Rate Envelope <input type="checkbox"/>
Date In 8 5 05	<input type="checkbox"/> 12 Noon <input checked="" type="checkbox"/> 3 PM	Postage \$ 13.65
Time In 1712	Military <input type="checkbox"/> 2nd Day <input type="checkbox"/> 3rd Day	Return Receipt Fee
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No Delivery <input type="checkbox"/> Weekend <input type="checkbox"/> Holiday	Acceptance Clerk Initials AN	Total Postage & Fees \$ 13.65

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NO DELIVERY <input type="checkbox"/>	Weekend <input type="checkbox"/> Holiday <input type="checkbox"/>
Customer Signature	

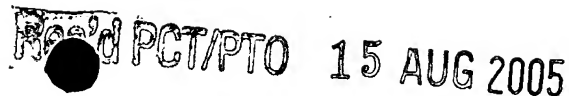
CUSTOMER USE ONLY	
METHOD OF PAYMENT: Express Mail Corporate Acct. No.	
Federal Agency Acct. No. or Postal Service Acct. No.	
FROM: (PLEASE PRINT) James L. Cordek Solae, LLC Building 3C PO Box 88940 St. Louis MO 63188 SP-1307 US Decl & Assignment	TO: (PLEASE PRINT) Thomas R. Katen 3875 Wildsire Willshire, OH 45898

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 Label 11-F August 2000

The Solae^{LLC}
Company

Rec'd PGT/PTO 15 AUG 2005

Solae, LLC
P.O. Box 88940
St. Louis, MO 63188 USA
800.325.7108

July 19, 2005

Express Mail Label No. EV 042960984 US

Thomas R. Katen
3875 Wildsire East Road
Willshire, OH 45898

EV042960984US

re: SP-1307 US Declaration for Patent Application titled, **FOOD COATING
COMPOSITION AND METHOD OF MAKING SAME**

Tom,


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I thank you for your cooperation.

Very truly yours,


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314.982.2409